

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BRUCE E. PRICE  
and BRETT W. KILHENNY

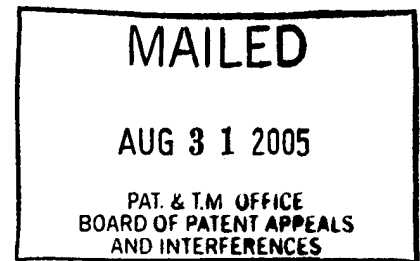
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Appeal No. 2005-2321  
Application 09/916,116

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ON BRIEF

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Before WARREN, JEFFREY T. SMITH and PAWLIKOWSKI, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*REMAND TO THE EXAMINER*

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.41.50(a)(1) (September 2004); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 2, May 2004; 1200-29 – 1200-30).

Appealed claim 1 is representative of the appealed claims and encompasses a foam cushion tape comprising at least the structure in sequence, as illustrated in specification **FIG. 1**, first adhesive layer **24** disposed on one side of compressible polyurethane foam layer **12**, which is disposed on a side of anchor layer **16**, which is disposed on one side of reinforcing layer **18**, with second adhesive layer **20** disposed on the other side of the reinforcing layer, wherein anchor

layer **16** and reinforcing layer **18** are at least a part of composite reinforcing film **14** (*see* specification, pages 4-7).<sup>1</sup>

We determine that the term “anchoring layer” in claim 1 has the broadest reasonable interpretation in context to one of ordinary skill in this art of a layer that anchors or secures compressible polyurethane foam layer **12** to reinforcing layer **18**. We will not limited the meaning of this term to the general description “comprises at least one non-olefinic polymer capable of forming a bond with a cured polyurethane” in the written description in the specification (page 4). *See, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Certain materials forming anchor layer **16** and reinforcing layer **18** are specified in appealed claim 5, dependent on claim 1, wherein each of the terms specify a type of material, not a specific compound *per se*.

The ground of rejection advanced in the answer is based on the acknowledged state of the art as described on pages 1-2 of specification (answer, page 3). The examiner finds that the acknowledged flexible foam tapes or foam cushion tapes comprise the sequence adhesive layer, compressible foam layer, reinforcing film, adhesive layer, and is “typically . . . manufactured by laminating a cast foam layer . . . to one side of a polyethylene terephthalate (PET) film (i.e., reinforcing layer) . . .” with adhesive layers on the foam layer and on the “PET film” (*id.*). The examiner further finds that appellants acknowledge that “it is known that, after use, the PET reinforcing film may delaminate from the foam during removal of the printing plate from a used tape (page 2, first full paragraph)” (*id.*).

We are of the opinion that the examiner’s findings as to the scope of the acknowledged prior art foam cushion tape generally described on pages 1-2 of the specification do not take into

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<sup>1</sup> Primer layer **22** shown in specification **FIG. 1** is included in tapes encompassed by claim 1 because of the open-ended transitional term “comprising” in this claim. *See generally, Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) (“The claimed composition is defined as comprising - meaning containing at least - five specific ingredients.”); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”).

account the acknowledged manufacturing step “[t]he buffered foam is subsequently laminated to one side of a one-mil polyethylene terephthalate (PET) film *using an adhesive*”, and the acknowledged problem that “after use, the PET may delaminate from the foam during removal of the printing plate from the used tape, *due to weak cohesive strength at the surface of the PET film*” (specification, page 2, ll. 6-7 and 10-12; emphasis supplied). We find that the “surface of the PET film” exhibiting “weak cohesive strength” is that surface of the PET film adhered via *adhesive* to the foam layer. The significance of the “adhesive” is further disclosed by appellants in describing the advantages of “casting a curable polyurethane foam composition directly onto the anchoring layer . . . followed by curing the foam composition to a compressible polyurethane foam” as including “eliminates the need for an adhesive between the reinforcing film and the foam layer of the cushion tape” (*id.*, page 3, ll. 9-10).

We further find no disclosure in the specification, including the specification Examples, with respect to the affect that the components of the adhesive layer between the foam layer and the PET film reinforcing layer of the acknowledged prior art tape have on the PET film layer with respect to the acknowledged weak cohesive strength at the surface of that layer. Indeed, neither the adhesive layer of the acknowledged prior art tape nor its contribution to the weak cohesive strength at the surface of the PET film layer is addressed in the answer, in the brief or the declaration of Brett W. Kilhenny executed July 3, 2003.

The difficulty, of course, in relying on the acknowledged state of the art as described in the written description of the specification is that such evidence is limited to that description. *Cf. In re Nomiya*, 509 F.2d 566, 570-71, 571 n.5, 184 USPQ 607, 611, 611 n.4 (CCPA 1975) (acknowledged prior art limited to the disclosure in the application with respect to Figs. 1 and 2). Thus, the examiner should develop and apply patent and non-patent literature references with respect to prior art foam cushion tapes, with and without an adhesive layer between the foam layer and the reinforcing film layer which apparently form the basis for the acknowledged state of the art at pages 1 and 2 of the specification.

With respect to the evidence provided in the acknowledged state of the art in the specification and in Birchall et al. (Birchall), in comparing the acknowledged prior art tape generally described on pages 1-2 and 5 of the specification with claim 1, the issue is raised as to

whether the broadest reasonable interpretation in context of the term “anchoring layer” in claim 1 encompasses an adhesive layer acknowledged to be part of the generally described prior art tapes. The issue is also raised as to whether the term “polyurethane” in claim 5 would encompass an isocyanate-ended polyurethane resin as disclosed in Birchall et al. (col. 22, l. 11).

With respect to the evidence provided in the acknowledged state of the art in the specification, if the examiner determines that the term “anchor layer” in claim 1 encompasses an adhesive layer, the issue raised under 35 U.S.C. § 102(b) is whether the acknowledged prior art tape containing an adhesive layer between the foam layer and the reinforcing film layer as generally described on pages 1-2 and 5 of the specification anticipates the claimed foam cushion tape encompassed by claim 1.

The presence of an adhesive layer in the acknowledged prior art foam cushion tapes generally described on pages 1-2 and 5 of the specification raises the issue under 35 U.S.C. § 103 (a) of whether, *prima facie*, one of ordinary skill in the art would have been motivated to modify the acknowledged prior art tape by replacing the adhesive layer thereof with other known anchoring layers which would adhere to the polyurethane layer and to the PET layer, such as the anchoring layers disclosed by Birchall as relied on by the examiner, in the reasonable expectation of adhering the two layers in the tape structure.

Furthermore, appellants reliance on unexpected results in the specification and in the declaration of Brett W. Kilhenny executed July 3, 2003 (brief, pages 7-8), raises the issue of whether such showings as relied on in the brief establish unexpected results based on direct or indirect evidence based on the closest prior that addresses the thrust of the rejection. *See e.g., Baxter Travenol Labs., supra* (“[W]hen unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared with the closest prior art. [Citation omitted.]”); *In re Burckel*, 592 F.2d 1175, 1179-80, 201 USPQ 67, 71 (CCPA 1979) (the claimed subject matter must be compared with the closest prior art in a manner which addresses the thrust of the rejection); *In re Blondel*, 499 F.2d 1311, 1317, 182 USPQ 294, 297-98 (CCPA 1974) (“Appellants’ brief goes through a detailed, step-by-step analysis of the evidence in support of the conclusion to be drawn from the indirect comparison . . . ,”

establishing that the indirect evidence provided a reliable indication of the performance of the closest claimed and prior art compounds).

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to address the issues we raised above as well as issues raised in these respects based on any other applicable prior art developed by the examiner, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This remand is made for the purpose of directing the examiner to further consider the ground of rejection. Accordingly, if the examiner submits a supplemental answer to the Board in response to this remand, “appellant must within two months from the date of the supplemental answer’s answer exercise one of” the two options set forth in 37 CFR §1.41.50(a)(2) (September 2004), “in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding,” as provide in this rule.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.



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